

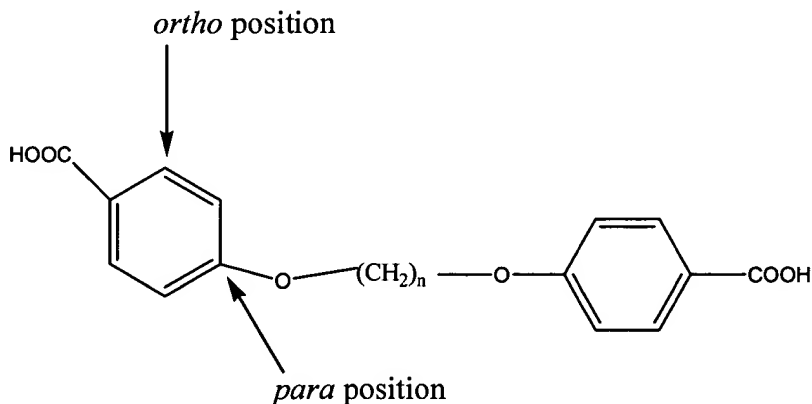
Remarks

Claims 1, 2, 3, 5, 7, 8, 12, 19, 20, 23, 24, 27, 31, 33, 34, 37, and 39 have been amended, claims 13, 15, 30, 32, 40, and 41 have been canceled, and new claims 42-51 have been added; as a result, claims 1-8, 10-12, 14, 16-28, 31, 33-34, 36-39 and 42-51 are pending.

Claims 1, and 10-26 were rejected under 35 U.S.C. § 102(b) as anticipated by EP 0580386. This rejection is respectfully traversed.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 U.S.P.Q.2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the art. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 101 (Fed. Cir. 1991). To overcome the defense of anticipation, "it is only necessary for the patentee to show some tangible difference between the invention and the prior art." *Del Mar Engineering Lab v. Physio-Tronics, Inc.*, 642 F.2d 1167, 1172, (9th Cir. 1981).

EP 0580386 (hereinafter '386) discloses an aromatic dicarboxylic acid having the formula:



The moiety O-(CH₂)_n-O in the above formula corresponds to group R in Applicant's claims and is substituted *para* to the carboxyl groups (COOH) on each of the two aromatic rings. The aromatic polyanhydride produced from this dicarboxylic acid has the O-(CH₂)_n-O moiety *para* to the anhydride group.

It is respectfully submitted that the polymers recited in the pending claims differ from the polymers discussed in the cited document in two ways. First, the polymers recited in the claims contain a group R that is substituted at the position *ortho* to the acid group on Ar – not *para*. There are no polymers disclosed in '386 having a group R as defined in the instant claims that is *ortho* to an acid group. Second, the polymers recited in the amended claims do not have ether linked R groups like the compounds discussed in '386.

Because the polymers recited in the instant claims differ from the polymers discussed in '386 in two distinct ways, the disclosure of '386 does not anticipate the instant claims. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 27-40 were rejected under 35 U.S.C. § 102(b) as anticipated by JP 61186309. This rejection is respectfully traversed.

Again, anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 U.S.P.Q.2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the art. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 101 (Fed. Cir. 1991).

The instant claims recite specific polymers that are not found in JP 61186309. Because JP 61186309 does not set forth every element found in Applicant's claims, there is no anticipation. Accordingly, withdrawal of this rejection is appropriate and is respectfully requested.

At page 5 of the Office Action, the Examiner states that "the reference discloses aromatic polyanhydrides prepared from the same components as claimed by applicants. It is respectfully submitted that this statement is incorrect. If the Examiner maintains the rejection, Applicant requests that the Examiner clearly point out where a recited polymer is specifically described in JP 61186309. Additionally, the Examiner goes on at page 5 to state "any differences not specifically mentioned appears to be conventional. Consequently the claimed invention cannot be deemed as novel...." In order to support a rejection under 35 U.S.C. § 102(b), there must be no difference whatsoever between the teaching of the reference and the claimed invention. Accordingly, the Examiner appears to have applied an incorrect legal standard to establish the

rejection. As discussed above, the instant claims recite specific polymers that are not found in JP 61186309. Accordingly, JP 61186309 does not anticipate the instant claims.

Claims 1-41 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite due to the presence of the term “substituted.”

The term substituted has been removed from the claims by the instant amendments. Accordingly, the Examiner’s ground for rejection has been obviated. Withdrawal of the rejection is respectfully requested.

Conclusion

Applicant respectfully submits that the pending claims (1-8, 10-12, 14, 16-28, 31, 33-34, 36-39 and 42-51) are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (952) 876-4092 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3503.

Respectfully submitted,

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Date March 20, 2006

By 

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of March, 2006.

Lynda Mau

Name


Signature